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|---------------------------------------|---|----------------------|
| In re Application of | : | |
| WANG, et al. | : | DECISION ON PETITION |
| Serial No.: 10/539,097 | : | |
| PCT No.: PCT/EP03/50955 | : | UNDER 37 CFR 1.47(b) |
| Int. Filing Date: 08 December 2003 | : | |
| Priority Date: 18 December 2002 | : | |
| Atty Docket No.: PP/1-22799/A/PCT | : | |
| For: PROCESS FOR THE PREPARATION OF A | : | |
| MELAMINE BASED FLAME RETARDANT | : | |
| AND POLYMER COMPOSITION | : | |

This decision is in response to the "Petition Under Rule 1.47(b)" filed 18 December 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 08 December 2003, applicant filed international application PCT/EP03/50955 which claimed priority to an earlier application filed 18 December 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 01 July 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 18 June 2005.

On 15 June 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and first preliminary amendment. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 12 October 2006, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$130.00 for filing the oath or declaration later than 30 months from the earliest priority date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 18 December 2006, applicant responded with the present petition which included a

certification pursuant to 37 CFR 1.8 that the present filing was deposited for mailing on 12 December 2006 and is thus considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(h); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1), (3), and (6).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

In the present case, applicant has not provided any evidence detailing the refusal of all six of the inventors to execute an oath or declaration. Applicant has merely stated that this is so. This is insufficient. In order to proceed pursuant to 37 CFR 1.47(b), applicant must show that all six of the listed inventors either refuse to execute an oath or declaration or cannot be found after a diligent effort. Additional information is available under MPEP section 409.03(d).

Regarding item (4), while the petition states that the person signing the declaration is an officer of Ciba Specialty Chemicals Corporation, this is not clear from the declaration as Mr. Finkelman's title has not been included. In addition, it does not appear that applicant has recorded an assignment in this application nor satisfied the provisions of 37 CFR 3.73(b). (See MPEP 409.03(b) and 324.

As to item (5), the original agreement in this case was between Sichuan University and DSM Malapur. Applicant states that Ciba Specialty Chemicals Holding, Inc. subsequently obtained the rights to said Agreement. However, applicant has not provided any documentation to support this statement. The original agreement provided that the results of the project shall entirely be DSM property. Applicant has provided an assignment chain from the inventors to Ciba Specialty Chemicals Holding, Inc. to Ciba Specialty Chemicals Corp. However, applicant has not shown how the inventors were able to assign rights which belonged to DSM to Ciba Specialty Chemicals Holding, Inc.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2)** **MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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